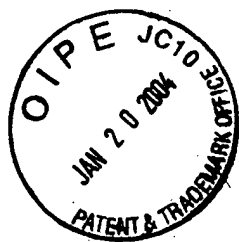


DOCKET NO.: ORTU-0007

PATENT
REISSUE LITIGATION



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Reissue Application of:

Raffa, et al.

U.S. Patent No.: 5,336,691

Issued: August 9, 1994

Application No.: 07/974,865

Group Art Unit: 1205*

Filing Date: November 10, 1992

Examiner: William R.A. Jarvis

For: Composition Comprising A Tramadol Material And Acetaminophen And Its Use

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

COMBINED REISSUE APPLICATION DECLARATION AND POWER OF
ATTORNEY BY INVENTOR(S) OR ASSIGNEE¹

(Complete A or B)

1. ☐ Declaration by Inventor(s):

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name; and

I verily believe that I am the original, first and sole inventor (if only one name is listed below), or an original, first and joint inventor (if plural names are listed below) of the subject matter that is claimed in letters patent number _____ granted on _____ and in the foregoing specification and for which invention I solicit a reissue patent;

2. ☒ Declaration by Assignee:

Note: The assignee of the entire interest may make the declaration if the reissue application does not seek to enlarge the scope of the claims of the original patent, 37 CFR §1.172.

I, Bernard Plantz, of Ortho-McNeil Pharmaceutical, Inc. declare that I am a citizen of the United States and resident of Holland, PA, that the entire title to letters patent number 5,336,691 for Composition Comprising a Tramadol Material and Acetaminophen and Its Use, granted on August 9, 1994 to McNeilab, Inc. is vested in Ortho-McNeil Pharmaceutical, Inc.,

* Enter the Group Art Unit and Examiner from which the original patent was issued.

¹ This declaration must be accompanied by Consent of Assignee for Reissue and Assignee's Statement of Ownership Interest.

that I believe said named inventor(s) to be an original, first and sole inventor (if only one name is listed) or an original, first and part inventor (if plural names are listed) of the subject matter that is described and claimed in the aforesaid letters patent and in the foregoing specification and for which invention I solicit a reissue patent.

ACKNOWLEDGMENT OF REVIEW OF PAPERS AND DUTY OF CANDOR

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims.

I acknowledge the duty to disclose all information known to be material to the patentability of this application in accordance with 37 CFR § 1.56.

- ☒ In compliance with this duty attached herewith is an Information Disclosure Statement in accordance with 37 CFR § 1.97.

PRIORITY CLAIM

I hereby claim foreign priority benefit under 35 U.S.C. § 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of any application on which priority is claimed.

- ☒ No such applications have been filed.
- ☐ Such applications have been filed as follows:

Country	Application No.	Date Filed	Priority Claimed
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STATEMENT OF INOPERATIVENESS OR INVALIDITY OF ORIGINAL PATENT 37 CFR §1.175

That I believe the original patent to be

- ☒ partly
- ☐ wholly

inoperative or invalid by reason of

- ☐ a defective ☐ specification, ☐ drawing, ☐ both
- ☒ said patent claiming
- ☒ more
- ☐ less

than patentee had a right to claim.

The scope of the claims of the original patent

- ☐ are enlarged
- ☒ are not enlarged

by this reissue application.²

Note: Here, the Declarant must state at least one error in the original patent and describe it, e.g., "by reason of a defective specification or drawing" or "by reason of the patentee claiming more or less than he had the right to claim in the patent," particularly specifying the defects and distinctly specifying the excess or insufficiency in the claims. It is no longer required to specify details as to how the error arose or occurred. If any errors are corrected during reissue prosecution that were not specified herein, a Supplemental Reissue Declaration must be filed prior to allowance in compliance with 37 CFR §1.175.

On information and belief, an error upon which this reissue application is based is that it was not appreciated, by the inventors and the attorney prosecuting the underlying patent application, that a composition within the scope of at least claim 1 as issued appears to have been disclosed in at least prior art U.S. Patent No. 3,652,589 (*see, e.g., col. 12*).

On information and belief, all errors being corrected in this reissue application up to the time of filing of this declaration under 35 CFR §1.175(a) arose without any deceptive intention on the part of the applicant.

OFFER TO SURRENDER ORIGINAL PATENT 37 CFR §1.178

Applicant hereby offers to surrender the original patent, the reissue of which is sought herein.

POWER OF ATTORNEY

² 35 U.S.C. § 251 forbids enlarging the scope of the original claims unless the reissue application is filed within two years of the grant of the original patent.

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith: Joseph Lucci and Jane E. Inglese, Registration Nos. 33,307 and 48,444 of the firm of **WOODCOCK WASHBURN LLP**, One Liberty Place - 46th Floor, Philadelphia, Pennsylvania 19103.

- ☐ Attached as part of this declaration and power of attorney is the authorization of the above named attorney(s) to accept and follow instructions from my representative.

Address all telephone calls and correspondence to:

Joseph Lucci
WOODCOCK WASHBURN LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103
Telephone No. 215-568-3100.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name: Robert B. Raffa	<hr/> Signature Date of Signature: _____ Citizenship: <u>United States</u>
Mailing Address: 4 Pacer Lane Norristown, PA	
City/State of Actual Residence: Norristown, PA	

Name: Jeffrey L. Vaught	<hr/> Signature Date of Signature: _____ Citizenship: <u>United States</u>
Mailing Address: 206 Kathleen Way Glenmoore, PA 19343	
City/State of Actual Residence: Glenmoore, PA	

Name:	<hr/> Signature Date of Signature: _____ Citizenship: _____
Mailing Address:	
City/State of Actual Residence:	

Name:	Signature Date of Signature: _____ Citizenship: _____
Mailing Address:	
City/State of Actual Residence:	

Name:	Signature Date of Signature: _____ Citizenship: _____
Mailing Address:	
City/State of Actual Residence:	

Name:	Signature Date of Signature: _____ Citizenship: _____
Mailing Address:	
City/State of Actual Residence:	

Note: Even though inventor(s) do not sign, complete above information for inventor(s)

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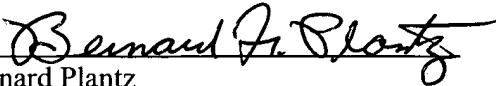
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PATENT
REISSUE LITIGATION

☒ By assignee or person authorized to sign on behalf of assignee:

Note: Execute only if inventors did not sign.

Ortho-McNeil Pharmaceutical, Inc.

By: 
Bernard Plantz
Assistant Secretary
Ortho-McNeil Pharmaceutical, Inc.

Check proper box(es) for any added page(s) forming a part of this declaration:

- ☐ Signature for fifth and subsequent joint inventors. Number of pages added .
- ☐ Signature by administrator(trix), executor(trix) or legal representative for deceased or incapacitated inventor. Number of pages added .
- ☐ Signature for inventor who refuses to sign or cannot be reached by person authorized under 37 CFR § 1.147. Number of pages added .
- ☐ Authorization of attorney(s) to accept and follow instructions from representative.

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P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

**CONSENT OF ASSIGNEE FOR REISSUE
and
ASSIGNEE'S STATEMENT OF OWNERSHIP INTEREST IN REISSUE**

1. In accordance with 37 CFR §1.172(a), **Ortho-McNeil Pharmaceutical, Inc.**, assignee of the entire interest in U.S. Patent No. **5,336,691**, granted on **August 9, 1994** to inventor(s) **Robert B. Raffa and Jeffrey L. Vaught**, hereby consents to reissue of said patent for the reasons set forth in the accompanying Reissue Declaration.
2. In accordance with 37 CFR §1.172(a), said assignee of the entire interest in United States Patent No. **5,336,691**, hereby establishes assignee's ownership of said patent and its right to take action therein under 37 CFR §3.73(b) by:

☒ specifying that evidence of said ownership is recorded in the Office for each assignment in the chain of title at Reel 6889, Frame 0415.

[Note: list reel and frame for each assignment in chain]

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**PATENT
REISSUE LITIGATION**

☐ enclosing herewith copies of executed assignment(s) dated _____ which have
been submitted for recording in the Office.

[Note: if other documentation is necessary to show ownership, the Office may require recordation thereof under 37 CFR §2.73(b).

Date: 1-16-04

By: Bernard J. Plantz
Bernard Plantz
Assistant Secretary
Ortho-McNeil Pharmaceutical, Inc.